

REMARKS

I. 35 USC 112-1 REJECTIONS

The Applicant respectfully traverses the 35 USC 112-1 rejections (the "112-1" rejections) for the reasons of record and for the additional reasons discussed herein.

For example, the response dated March 28, 2002 addressed the '112-1 rejections in Section 1.2 therein (outlined below), which is herein incorporated by reference.

1.2	35 USC 112-1 REJECTION	6
1.2.1	Introduction	6
1.2.2	The Rejection Does Not Establish A Prima Facie Case	6
1.2.3	The Claim Terminology Does Not Have To Be Stated Verbatim	7
1.2.4	The Disclosure Is Presumptively Correct	9
1.2.5	The Examiner Alleges Insufficient Disclosure While Ignoring Extensive Relevant Recitations In The Disclosure	10
1.2.6	The Rejections Fail To Establish The Level Of Skill In The Art	11
1.2.7	The § 112-1 Rejections Regarding Product Terminology Are Improper In Light Of The Statute And The Law Of The Federal Circuit .	11

Further, the Appeal Brief dated August 2, 2004 in related copending application Serial No. 08/471,703 before the same examiner addressed '112-1 rejections in Section 8.2 therein (outlined below), which is herein incorporated by reference.

8.2	THE § 112-1 WRITTEN DESCRIPTION REJECTIONS	17
8.2.1	The Fact That The Appellant Reduced-To-Practice An "Prototype System" Is Very Significant To The § 112-1 Rejections	18
8.2.2	The Instant Disclosure According To The CCPA, The Federal Circuit, And The PTO Is Legally Correct And Presumptively Valid	19
8.2.3	An Overview Of The Computer Disclosure	21

8.2.4	The § 112-1 Rejections Fail To Consider The Disclosure As A Whole	24
8.2.5	Having Met The Requirement for Enablement, Written Description Has Also Been Met In This Case	24
8.2.6	The Examiner Alleges Insufficient Disclosure While Ignoring Hundreds Of Relevant Recitations In The Disclosure	25
8.2.7	Claim Terminology Does Not Have To Be Stated <u>Verbatim</u> In The Disclosure To Satisfy The Written Description Requirement	26
8.2.8	The CCPA <u>In Banc</u> Decision In <u>Angstadt</u> Is Dispositive Of The § 112-1 Rejections	29
8.2.9	The Description More Than Meets The Law On Written Description	30
8.2.10	The Federal Circuit Analyzes Written Description On An Individual Limitation-By-Limitation Basis In Simple Tabular Form	38
8.2.11	The § 112-1 Rejections Do Not Establish A <u>Prima Facie</u> Case	41

II. 35 USC 112-2 REJECTIONS

It is the Appellant's statutory right to define what he (the Appellant) regards as his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

§ 112-2 (emphasis added).

Judge Stewart in Hyatt-'211⁶ stated:

6. Ex parte Hyatt, Appeal No. 91-2061, Paper No. 28 at 9 in patent application Serial No. 07/662,211 (PTO Bd. App. December 20, 1991) [herein Hyatt-'211] (unpublished PTO decision).

The second paragraph of 35 USC 112, gives appellant, expressly, the right to define what appellant regards as his invention. Appellant has done so in setting forth his claims. Appellant is totally free to structure the claims in this regard subject to the other requirements of law and regulation. We have considered, in detail, the language objected to by the examiner, but find the language to be reasonably descriptive of the invention. In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). Accordingly, we will not sustain the rejection.

Similarly, the Appellant here has defined what he regards as his invention. Hence, the § 112-2 rejections fail to establish a prima facie case and should not be sustained.

The MPEP expressly prohibits these type of rejections.

It is applicant's responsibility to select proper wording of the claim, except to the extent that the selection of words makes the claims indefinite. Under no circumstances should a claim be rejected merely because the examiner prefers a different choice of wording.

MPEP 706.03(d) (emphasis added). However, the Examiner has failed to establish which words are indefinite and for what reasons. Conversely, a simple reading of the subject claims confirms that the words are definite.

MPEP 706.03(d) prohibits the Examiner from merely requiring a different choice of wording.

The examiner has the responsibility to make sure the wording of the claims is sufficiently definite to reasonably determine the scope Under no circumstances should a claim be rejected merely because the examiner prefers a different choice of wording.

The MPEP requires the Examiner to be reasonable.

... he or she [the Examiner] should allow claims which define the patentable novelty with a reasonable degree of particularity and distinctness.

MPEP 706.03(d) (emphasis in MPEP). But the instant § 112-1 rejections are unreasonable.

The examiner has the responsibility to make sure the wording of the claims is sufficiently definite to reasonably determine the scope.

MPEP 706.03(d) (emphasis in the MPEP). But the § 112-2 rejections are improperly directed to the subject matter of the claims. Hence, the § 112-2 rejections fail to establish a prima facie case

It is well established that it is the purpose of the disclosure to provide enablement and it is the purpose of the claims to define the boundary of the patent monopoly.

Distinguishing what infringes from what doesn't is the role of the claims, not of the specification.

Gore.⁷

A claim is a group of words defining only the boundary of the patent monopoly. It may not describe any physical thing and indeed may encompass physical things not yet dreamed of.

Vogel.⁸

III. TRAVERSE OF 37 CFR 1.83 OBJECTIONS

The Applicant traverses the 37 CFR 1.83 objection (THE "'83 objection") for the reasons of record. For example, the figures properly show the claim limitations. See the Appeal Brief dated August 2, 2004 in related copending application Serial No. 08/471,703 before the same examiner addressed the disclosure in Section 8.2 therein, which is herein incorporated by reference. See particularly Sections 8.2.1, 8.2.3, and 8.2.6 therein. See also broad block diagrams Figs. 1, 3, and 4 and detailed diagrams Figs. 6A-19.

7. W.L.Gore & Associates, Inc., v. Garlock, Inc., 721 F.2d 1540, 1557 (Fed.Cir. 1983).

8. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

The '83 objections do not establish a prima facie case. For example, the subject features are shown and are recited at numerous places in the extensive disclosure, but the objections completely disregard the extensive disclosure and instead makes general statements about the absence of the subject features in the disclosure.

The '83 objections are improper constructive rejections of claims and are in conflict with the 35 USC 112-1 rejection. For example, this issue is covered by the 35 USC 112-1 rejection in the instant action and this issue is clearly appealable; hence this issue cannot also be covered by an objection which is petitionable.

It is well established that it is the content and not the form of the disclosure that is important In re Sherwood, 204 USPQ 537, 545 footnote 8 (CCPA 1980). The claim elements are shown in the figures sufficient to meet 37 CFR 1.83(a). A requirement for any more would violate In re Sherwood.

The Examiner's conclusory statements objecting to the drawings are not evidence and certainly not the required "substantial evidence" (see below). However, the drawings themselves constitute "substantial evidence", are presumed to be correct,⁹ and satisfy § 112-1 and the PTO requirements regarding drawings. Hence, clarification is requested regarding the particular claim limitations that the Examiner contends are missing from the drawings and reasons why the drawings as filed do not illustrate such claim limitations.

35 USC § 113 establishes that a drawing isn't even necessary ("The applicant shall furnish a drawing where necessary.... When the nature of such subject matter admits of illustration by a drawing" (emphasis added)).

37 CFR § 1.83(a) establishes that a labeled box is suitable ("conventional features disclosed in the description ... should

9. See MPEP 2164.04. See also In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1967).

be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box) ").

The objection mischaracterizes the issue. There is nothing in the drawings that is objectionable, it is the recitations in the claims that the Examiner finds objectionable. The Examiner cannot object to the drawings for what is not shown in the drawings, there is nothing inherently wrong with the drawings by themselves. The Examiner is actually objecting to the claims as not having a basis in the drawings. However, this issue must involve a rejection. Without a rejection involving the drawings, the Examiner cannot make an objection to the drawings. This is because "[the Board's] decision regarding the § 112 rejection governs the merits of the objection". The objection based on the language of the claims cannot stand alone without a rejection. See Ex parte Kazmierczak,¹⁰ at 5.

The Federal Circuit requires "substantial evidence" to support a rejection. See Gartside and Kotzab.¹¹

The reviewing court shall --

* * *

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be --

* * *

(E) unsupported by substantial evidence

Gartside.¹²

10. Ex parte Kazmierczak, Appeal No. 97-3469 (Bd. Pat. App. & Int.) (unpublished opinion), at <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd973469.pdf>. See also U.S. Patent No. 6,005,751 (issued December 21, 1999 to Kazmierczak).

11. In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000); In re Kotzab, 55 USPQ2d 1313 (Fed. Cir. 2000).

12. In re Gartside, 53 USPQ2d 1769, 1773 (Fed. Cir. 2000).

IV. THE EXAMINER HAS FAILED TO PROVIDE THE REQUIRED
"SUBSTANTIAL EVIDENCE" AND HAS FAILED TO ESTABLISH
A PRIMA FACIE CASE TO COUNTER THE APPELLANT'S
ENTITLEMENT TO A PATENT

The Applicant respectfully traverses the rejections and objections for the reasons of record and for the additional reasons discussed herein.

For example, the response dated March 28, 2002 addressed the requirement for the Examiner to support the rejections and objections with "substantial evidence" in Section VI therein (outlined below), which is herein incorporated by reference.

1.1	THE EXAMINER HAS FAILED TO PROVIDE THE REQUIRED "SUBSTANTIAL EVIDENCE" AND HAS FAILED TO ESTABLISH A PRIMA FACIE CASE TO COUNTER THE APPELLANT'S ENTITLEMENT TO A PATENT	1
1.1.1	The Applicant Is Entitled To A Patent	2
1.1.2	The U.S. Supreme Court And The Federal Circuit Require "Substantial Evidence" To Support A Rejection	3
1.1.3	The Examiner Relies On Conclusory Statements, Which Are Expressly Discouraged By The Federal Circuit And By The U.S. Supreme Court	5

V. ART REJECTIONS

5.1 35 USC 103 Rejections

The Applicant respectfully traverses the 35 USC 103 rejections for the reasons of record and for the additional reasons discussed herein. For example, the response dated March 28, 2002 addressed the 35 USC 103 rejections in Section 1.3 therein, which is herein incorporated by reference.

The § 103 rejections do not properly address the nature of the references nor the combinations of the references. For example, the rejections do not establish why such references are pertinent to the instant claimed invention. Further, the references are directed to different types of systems with different types of implementations therebetween where the manner of making the combinations is not obvious.

Dunn '024 is directed to a "narrow band digital speech communication system".

Boone '351 is directed to a 4-function (add, subtract, multiply and divide) "basic desk top calculator".

Merely finding disconnected bits-and-pieces in the prior art is insufficient.

The Examiner has not properly established how such diverse references can be combined. See Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991).

When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc., 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1994).

In an appeal in application Hyatt 355,¹³ Judge Barrett clarified the requirement for motivation:

[T]hat a fact may be well known ... does not itself provide the motivation for the combination.

13. Ex parte Hyatt, Appeal No. 1994-3042, Paper No. 39 at 36 in patent application Serial No. 07/289,355 (PTO Bd. App. December 21, 2000) [herein Hyatt-355] (unpublished PTO decision).

The art rejections in the appeal in this Hyatt '355 application¹⁴ were all reversed.

The examiner in Hyatt-'355 relied on improper hindsight to support § 103 rejections. Thus, the Board reversed all of the § 103 rejections in Hyatt-'355:

The examiner fails to show a suggestion of the limitations in the prior art. "Obviousness may not be suggested using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)). "'[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

* * *

Although Hobrough teaches "automatic registration of photographic images," col. 3, ll. 49-50, the examiner fails to identify a sufficient suggestion to add the automatic registration of Hobrough to the system of Hemstreet. There is no evidence that the sample and the patterns to be compared in Hemstreet are misregistered so as to benefit from registration.

* * *

... the examiner fails to allege, let alone show, that the reference cures the deficiency of Hemstreet and Hobrough.

Hyatt-'355 at 27-29.

14. Ex parte Hyatt, Appeal No. 1994-3042, Paper No. 39 in patent application Serial No. 07/289,355 (PTO Bd. App. December 21, 2000) [herein Hyatt-'355] (unpublished PTO decision).

5.2 35 USC 102 Rejections

The Applicant respectfully traverses the 35 USC 102 rejections for the reasons of record and for the additional reasons discussed herein. For example, the response dated March 28, 2002 addressed the 35 USC 102 rejections in Section 1.4 therein, which is herein incorporated by reference.

Dunn, relied on for the § 102 rejection, does not provide the identity necessary to support the § 102 rejections.

The 35 USC 102 rejection does not establish a prima facie case. For example, the Federal Circuit **requires** that a '102 rejection must be supported on a limitation by limitation basis with specific fact findings for each contested limitation and satisfactory explanations for such findings. Claim construction must also be explicit. Gechter v. Davidson, 43 USPQ2d 1031 at 1035.

Further, under 35 USC 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. In re Bond, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) as cited in Gechter v. Davidson, 43 USPQ2d 1031 at 1032.

The law requires **identity** between the rejected claims and the references for a 35 USC 102 rejection; as discussed below. However, the rejection does not establish this identity. This is not surprising, there is no such identity. The claims have features that distinguish over the references.

VI. AMENDMENTS

No amendments are proposed herein.

CERTIFICATION OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 3, 2004.

Respectfully submitted,

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